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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,138	12/31/2003	Scott W. Allan	PAT 51682A-2 US	6866
26123 7590 01/30/2008 BORDEN LADNER GERVAIS LLP Anne Kinsman WORLD EXCHANGE PLAZA 100 QUEEN STREET SUITE 1100 OTTAWA, ON K1P 1J9 CANADA			EXAMINER GATES, ERIC ANDREW	
			ART UNIT 3722	PAPER NUMBER
			NOTIFICATION DATE 01/30/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

10/748,138

Applicant(s)

ALLAN ET AL.

Examiner

Eric A. Gates

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 12-18 and 32-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 12-17, 32, 33, 35 and 36 is/are rejected.
- 7) ☒ Claim(s) 18 and 34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

1. This office action is in response to applicant's amendment filed 22 October 2007.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 32, 33, 35, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Brydon (U.S. Patent 5,114,285).
4. Regarding claim 32, Brydon discloses a lock template assembly 10, comprising: an end template (70 and the immediate adjacent portions of sides 50 and 60) including a base portion 70 with at least one center hole 80 to align with a center line of a door edge when positioned on a door (see column 2, lines 58-61); at least one side template 50 (the portion not included in the end template) connected to the end template; biasing means (convergent sides as seen in figure 3, see column 2, lines 55-57) cooperating with the at least one side template to accommodate door edges of varied widths and to hold the at least one side template substantially flush to a respective door surface; and marking means 80 disposed in the at least one side template to mark a location of a striker plate on an adjacent door jamb when the side template is moved from a position substantially flush to the door surface to a position adjacent the door jamb (the

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assembly may be removed from the door surface and placed adjacent the door jamb to mark the striker plate location to meet the structural requirement of this intended use limitation).

5. Regarding claim 33, Brydon discloses a lock template assembly 10, comprising: an end template (70 and the immediate adjacent portions of sides 50 and 60) including a base portion 70 with at least one center hole 80 for alignment with a center line of a door edge when positioned on a door (see column 2, lines 58-61); at least one side template 50 (the portion not included in the end template) connected to the end template; biasing means (convergent sides as seen in figure 3, see column 2, lines 55-57) cooperating with the at least one side template to accommodate door edges of varied widths and to hold the at least one side template substantially flush to a respective door surface; self-alignment means (the convergent sides as seen in figure 3 will self-align the template on a door) provided on at least one of the biasing means and the at least one side template to ensure proper alignment between the at least one of the biasing means and the at least one side template; and marking holes or slots 80 disposed in the at least one side template for providing cylinder hole location marking and striker plate location marking (the assembly may be removed from the door surface and placed adjacent the door jamb to mark the striker plate location to meet the structural requirement of this intended use limitation).

6. Regarding claim 35, Brydon discloses a door hardware installation template assembly 10, comprising: an end template (70 and the immediate adjacent portions of sides 50 and 60) including a base portion 70 having at least one center hole 80 to align

with a center line of a door edge when positioned on a door (see column 2, lines 58-61); at least one side template 50 (the portion not included in the end template) connected to the end template; biasing means (convergent sides as seen in figure 3, see column 2, lines 55-57) cooperating with the at least one side template to accommodate door edges of varied widths and to hold the at least one side template substantially flush to a respective door surface; and marking means 80 disposed in the at least one side template to provide cylinder hole and striker plate location marking (the assembly may be removed from the door surface and placed adjacent the door jamb to mark the striker plate location to meet the structural requirement of this intended use limitation).

7. Regarding claim 36, Brydon discloses wherein the marking means include guide holes 80.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 2, 4-8, and 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brydon (U.S. Patent 5,114,285) in view of Miller (U.S. Patent 5,249,336).

10. Regarding claims 1, 13, and 14, Brydon discloses a lock template assembly 10, comprising: an end template (70 and the immediate adjacent portions of sides 50 and

60) including a base portion 70 with at least one center hole 80 for alignment with a center line of a door edge when positioned on a door (see column 2, lines 58-61); at least one side template 50 (the portion not included in the end template) connected to the end template; biasing means (convergent sides as seen in figure 3, see column 2, lines 55-57) cooperating with the at least one side template to accommodate door edges of varied widths and to hold the at least one side template substantially flush to a respective door surface; and marking means 80 disposed in the at least one side template to provide cylinder hole location when the at least one side template is held substantially flush to the door surface.

Brydon does not disclose wherein the at least one side template is pivotably connected to the end template, or to provide striker plate height and location when the at least one side template is pivoted to lie adjacent a door jamb, or wherein the at least one side template includes a non-marking protection cap, or further including grip means applied to an inside surface of at least one of the biasing means and the at least one side template.

Miller teaches the use of a clip 1 that comprises a clamping element 2 with opposed gripping means 5 that are pivotably connected to the clamping element for the purpose of using the gripping means to open the clamping element. The gripping means include sleeves 3/4 for the purpose of making it easier and more comfortable to grip the gripping means and for the purpose of preventing damage to the surface of the clamped item. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the assembly of Brydon with

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the pivoting gripping means and sleeves of Miller in order to have a lock template assembly that is easier to attach to the door in a manner which is more comfortable to the user and is less likely to damage the surface of the door, and which improves the grip of the side template to the surface of the door, and which allows the side templates to pivot from flush to the door to a position adjacent the door jamb for marking striker plate height.

While the sleeves of Miller could not be used in the shape disclosed by Miller, it would have been an obvious matter of design choice to make the different portions of the sleeves of whatever form or shape was desired or expedient, such as for the purpose of only covering the portions of the side templates not used for marking. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results.

11. Regarding claim 2, Brydon discloses wherein the marking means 80 include guide holes.

12. Regarding claim 4, Brydon discloses wherein the biasing means include a resilient thermoplastic material (see column 3, lines 17-20).

13. Regarding claim 5, Brydon discloses wherein the biasing means includes the end template formed as a generally U-shaped spring clip having two sides.

14. Regarding claim 6, Brydon discloses wherein the U-shaped spring clip applies substantially equal and opposing forces to the door to align the base portion with the center line (this is an inherent feature of the symmetrical clip).

15. Regarding claim 7, Brydon discloses having two side templates 50/60 (portions not included in the end template).
16. Regarding claim 8, Brydon discloses wherein the at least one side template 50 includes an offset tip (in as much as the tip of the template [edge away from the end portion 70] is offset from the end portion 70).
17. Regarding claim 12, Brydon discloses wherein the biasing means is a spring clip 60 attached to the end template opposite to the at least one side template 50 (the opposite side template 60 functions as a spring clip in figure 3).
18. Regarding claim 15, Brydon discloses wherein the end template includes temporary fastener holes 80 for securing the template assembly to the door edge (the holes 80 in end portion 70 meet the structural requirement of this intended use limitation).
19. Regarding claim 16, Brydon discloses including further marking means 80 for providing a striker plate height and location on an adjacent doorjamb (the holes 80 in side portion 50 meet the structural requirement of this intended use limitation).
20. Regarding claim 17, Brydon discloses further including self-alignment means (the convergent sides as seen in figure 3 will self-align the template on a door) provided on at least one of the biasing means and the at least one side template to ensure proper alignment between the at least one of the biasing means and the at least one side template.
21. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brydon.



22. Regarding claim 3, Brydon discloses the invention substantially as claimed, except Brydon does not disclose wherein the biasing means include spring steel. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the clip from spring steel instead of plastic for the purpose of having a clip that is more resistant to breaking, because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

***Allowable Subject Matter***

23. Claims 18 and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

24. Applicant's arguments with respect to claims 1, 2, 4-8, and 12-17 have been considered but are moot in view of the new ground(s) of rejection.

25. Applicant's remaining arguments filed 22 October 2007 have been fully considered but they are not persuasive.

26. In response to applicant's argument regarding claims 32 and 33 that Brydon does not disclose "means that permits marking of the striker plate location on an adjacent door jamb" and "holes and slots disposed in the side template that provide both cylinder and hole location marking", a recitation of the intended use of the claimed invention

must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

27. In response to applicant's argument that "no one of skill in the art would be motivated to combine the door drilling template of Brydon with the plastic binder clip of Miller", the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

28. For the reasons as set forth above, the rejections are maintained.

### ***Conclusion***

29. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Gates whose telephone number is (571) 272-5498. The examiner can normally be reached on Mon-Thurs 8:45 - 6:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



EAG  
17 January 2008



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